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Atty Docket No. 19-2042 US025009

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of	:	
Shinpei OKAJIMA	:	Appeal No.: _____
Serial No.: 10/076,956	:	Group Art Unit: 3728
Filed: February 19, 2002	:	Examiner: Anthony D. Stashick
For: BOOT LINER	:	

THE ASSISTANT COMMISSIONER OF PATENTS  
Washington, D.C. 20231

Sir:

Transmitted herewith is Applicant's Brief on Appeal in the above-identified application.

The item(s) checked below are appropriate:

- [X] Appeal fee (37 CFR 1.17(f))
- [X] other than small entity - \$500.00  
[ ] small entity - \$250.00
- [X] A check in the amount of \$500.00 is attached.
- [X] The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No.: 19-2042. A duplicate copy of this sheet is attached.
- [X] Any additional excess claim fees under 37 CFR 1.16.
- [X] Any additional patent application processing fees under 37 CFR 1.17.

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Shinpei OKAJIMA

Serial No.: 10/076,956

Filed: February 19, 2002

For: **BOOT LINER**

Appeal No.: \_\_\_\_\_

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# APPEAL BRIEF

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**APPEAL BRIEF**

Commissioner of Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231

Sir:

For the appeal to the Board of Patent Appeals and Interferences from the decision dated January 10, 2006 of the Examiner twice rejecting claims 6-13 and 15-28, Applicant-Appellant submits the following brief in accordance with 37 C.F.R. §41.37.

In view of the following analysis of claims 6-13 and 15-28, Appellant believes that the unique arrangements of these claims are not disclosed or suggested in the references cited in the Office Action, either alone, or in combination. Thus, Appellant respectfully requests that the rejections of claims 6-13 and 15-28 be reversed, and that claims 6-13 and 15-28 be allowed.

If there are any questions regarding this Brief, please feel free to contact the undersigned.

***1. Real Party In Interest***

Shimano, Inc. is the owner in the above-identified patent application. Thus, the real party in interest is Shimano, Inc.

## ***2. Related Appeals and Interferences***

Appellant and Appellant's legal representatives are not aware of any appeals or interferences relating to the above-identified patent application.

### ***3. Status of Claims***

Claims 6-13 and 15-28 are presently pending in this application. Claims 6-13 and 15-28 stand rejected.

Claims 6-13 and 15-28 stand twice rejected in view of prior art. Specifically, claims 6, 7, 9-13, 17-21, 23, 26 and 27 stand rejected under §103(a) as being unpatentable over U.S. Patent No. 6,012,236 to Pozzobon in view of U.S. Patent No. 3,925,916 to Garbuio and U.S. Patent No. 5,746,015 to Clement et al. Claims 8, 15, 16, 22, 24, 25 and 28 stand rejected under §103(a) as being unpatentable over the Pozzobon patent in view of the Garbuio patent and the Clement et al patent and in further view of U.S. Patent No. 5,775,006 to Breuner. Claims 6-13 and 15-28 have been twice rejected. Thus, all of the rejected claims 6-13 and 15-28 are on appeal.

#### ***4. Status of Amendments***

The claim amendments of December 14, 2004 were entered before the current rejection. Therefore, all claim amendments have been entered and considered by Examiner Stashick.



### ***5. Summary of Claimed Subject Matter***

The presently claimed invention is directed to a boot liner 10 that has a sole portion 12 and an upper portion 14. The upper portion 14 has a foot section 20, an ankle section 21 and a leg section 22. The foot section 20 is fixedly coupled to the sole portion 12. The ankle section 21 extends upwardly from the foot section 20. The leg section 22 extends upwardly from the ankle section 21. Referring to Figures 3 and 4 of the instant application, the ankle section 21 has a pair of non-thermoformable members 29 that form first and second banana-shaped pads B. The first banana-shaped pad B is located in an outer side of the ankle section 21 and the second banana-shaped pad B is located in an inner side of the ankle section 21. See page 7, lines 15-22 of the specification. Referring to Figures 3-6, the upper portion 14 has a thermoformable layer 28b on the inner side and the outer side of the ankle section 21. The claimed invention is discussed on pages 2-10 of the specification and illustrated in Figures 1-6.

The boot liner 10 of independent claim 8 basically comprises a sole portion 12 and an upper portion 14 as discussed above. The upper portion 14 includes a tightening device T that is fixed to the upper portion 14. The tightening device T has a first strap portion 45 and a second strap portion 46. The first strap portion 45 overlies a part of the first banana-shaped pad B. The second strap portion 46 overlies a part of the second banana-shaped pad B. See page 7, lines 27-29 and Figures 1, 2 and 4. The first and second banana-shaped pads B are configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint A of the wearer. See page 7, line 30 to page 8, line 1 of the specification and Figure 4.

The boot liner 10 of independent claim 13 basically comprises a sole portion 12 and an upper portion 14. The upper portion 14 has a foot section 20, an ankle section 21 and a leg section 22. The foot section 20 is fixedly coupled to the sole portion 12. The ankle section

21 extends upwardly from the foot section 20. The leg section 22 extends upwardly from the ankle section 21. The upper portion 14 includes a thermoformable layer 28b and first and second banana-shaped pads B. The thermoformable layer 28b is located on an inner side and an outer side of the ankle section 21. The first banana-shaped pad B is located in the outer side of the ankle section 21. The second banana-shaped pad B is located in the inner side of the ankle section 21. The first and second banana-shaped pads B are constructed of a different material than the thermoformable layer 28b. See page 8, lines 11-14 of the specification. Each of the first and second banana-shaped pads B is thicker than the thermoformable layer 28b of the ankle section 21 and extends laterally towards each other relative to the thermoformable layer 28b of the ankle section 21. See page 7, lines 4, 5 and 25-27 of the specification and Figures 3, 5 and 6. The first and second banana-shaped pads B are configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint A of the wearer. Referring to Figures 5 and 6, the upper portion 14 includes an inner layer 28c or 28d disposed on an interiorly facing side of the thermoformable layer 28b with the first and second banana-shaped pads B located between the thermoformable layer 28b and the inner layer 28c or 28d.

The boot liner 10 of independent claim 28 basically comprises a sole portion 12 and an upper portion 14. The upper portion 14 has a foot section 20, an ankle section 21 and a leg section 22. The foot section 20 is fixedly coupled to the sole portion 12. The ankle section 21 extends upwardly from the foot section 20. The leg section 22 extends upwardly from the ankle section 21. The upper portion 14 includes a thermoformable layer 28b and first and second banana-shaped pads B. The thermoformable layer 28b is located on an inner side and an outer side of the ankle section 21. The first banana-shaped pad B is located in the outer side of the ankle section 21. The second banana-shaped pad B is located in the inner side of the ankle section 21. The first and second banana-shaped pads B are constructed of a

different material than the thermoformable layer 28b. See page 8, lines 11-14 of the specification. Each of the first and second banana-shaped pads B is thicker than the thermoformable layer 28b of the ankle section 21 and extends laterally towards each other relative to the thermoformable layer 28b of the ankle section 21. See page 7, lines 4, 5 and 25-27 of the specification and Figures 3, 5 and 6. The first and second banana-shaped pads B are configured and arranged to support an ankle joint of a wearer of the boot liner at bottom and rearward sides of the ankle joint A of the wearer. The upper portion 14 includes a tightening device T that is fixed to the upper portion 14. The tightening device T has a first strap portion 45 and a second strap portion 46. The first strap portion 45 overlies a part of the first banana-shaped pad B. The second strap portion 46 overlies a part of the second banana-shaped pad B.

***6. Grounds of Rejection to be Reviewed on Appeal***

The grounds of rejection to be reviewed on appeal is presented as follows:

- (A) Whether claims 6, 7, 9-13, 17-21, 23, 26 and 27 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,012,236 to Pozzobon in view of U.S. Patent No. 3,925,916 to Garbuio and U.S. Patent No. 5,746,015 to Clement et al.
- (B) Whether claims 8, 15, 16, 22, 24, 26 and 28 are unpatentable under 35 U.S.C. §103(a) over the Pozzobon patent in view of the Garbuio patent and the Clement et al patent and in further view of U.S. Patent No. 5,775,006 to Breuner.

## **7. Arguments**

The claims on appeal are not rendered obvious by U.S. Patent No. 6,012,236 to Pozzobon (hereinafter “Pozzobon patent”) in view of U.S. Patent No. 3,925,916 to Garbuio (hereinafter “Garbuio patent”) and U.S. Patent No. 5,746,015 to Clement et al (hereinafter “Clement et al”) and further in view of U.S. Patent No. 5,775,006 to Breuner (hereinafter “Breuner patent”), whether taken singularly or in combination.

### **BRIEF SUMMARY OF ARGUMENTS**

- One of ordinary skill in the art would not combine the Pozzobon, Garbuio and Clement et al patents because there is no suggestion or motivation to make the proposed modification.
- The combination of the Pozzobon, Garbuio, Clement et al and Breuner patents does not show all of the claimed elements. For this reason, a *prima facie* case of obviousness has not been established.

The foregoing arguments are explained in more detail below.

A. **Rejection under 35 U.S.C. §103(a) over the Pozzobon patent in view of the Garbuio patent and the Clement et al patent**

*The Pozzobon, Garbuio and Clement et al patents are not combinable because there is no suggestion or motivation to combine.*

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01

The Pozzobon patent discloses an innerboot 1 that has a layer 3, 103 of thermoformable material. The innerboot 1 has a layer 5 of *vapor-permeable* material, a plurality of channels 7, 107 and a plurality of holes 4, 104 for ventilation. The Pozzobon patent states at column 2, lines 2-7 that a principal aim of the present invention is to provide an innerboot 1 made of thermoformable material to achieve optimum ventilation of the foot.

The Garbuio patent discloses a flexible insert 2 for a boot 1. The boot 1 has a pair of elastic pads 8. The insert 2 has an *air-impervious* section A that is bounded by a closed seam 7 and overlain by fabric layers 3. Referring to Figures 1 and 2, the air-impervious area A exteriorly faces the interiorly facing pad 8 of the boot 1.

The Clement et al patent discloses a liner 1 with a simply compressible foam 13 between an exterior wall 11 and an interior wall 12. The liner 1 has wedging elements 5 and 6 that are formed from a thermoplastic material. Referring to Figures 1 and 2, the wedging element 5 is placed in a heel section of the liner 1 between the exterior wall 11 and the interior wall 12.

Appellant respectfully asserts that one of skill in the art would not modify the *innerboot 1* of the Pozzobon patent with the pad 8 of the *boot 1* of the Garbuio patent. Indeed, the Pozzobon patent does not disclose a boot. It is unclear why one of ordinary skill

in the art would be motivated to take features of the *boot 1* of the Garbuio patent and apply the features to the *innerboot 1* of the Pozzobon patent.

Furthermore, the interiorly facing pad 8 of the boot 1 in the Garbuio patent is intended to work in conjunction with the exteriorly facing *air-impervious* area A of the liner 2. See column 2, lines 35-38 of the Garbuio patent. Thus, any use of the pad 8 would necessarily require use of the *air-impervious* area A of the insert 2.

“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01 V. citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Appellants respectfully assert that modification of the innerboot 1 of the Pozzobon patent with the insert 2 and the pad 8 of the Garbuio patent would render the innerboot 1 unsatisfactory for its intended purpose.

The Pozzobon patent states at column 2, lines 2-7 that a principal aim of the present invention is to provide an innerboot made of thermoformable material to achieve optimum ventilation of the foot. The Pozzobon patent uses the *vapor-permeable* material 5, the plurality of channels 7 and the plurality of holes 4 to ensure proper ventilation of the foot.

In contrast, the Garbuio patent discloses the *air-impervious* area A of the insert 2 that is bound by the closed seam 7 to form the sealed envelope. Moreover, the fabric layers 3 are impregnated with resin to form *an air-tight envelope* around an open-celled core portion 4a.

Most importantly, the Garbuio patent states at column 2, lines 35-38:

Any lateral pressure acting upon this pad [8] will be distributed by the resilient core 4a over the entire area A for effective cushioning of the foot without materially impeding its mobility.

Therefore, in order to properly use the pad 8 of the Garbuio patent, an *air-impervious* area A must be used in conjunction with the pad 8. Accordingly, providing the pad 8 and the *air-impervious* area A on the innerboot 1 of the Pozzobon patent would completely go

against the original intent of the Pozzobon patent to achieve optimum ventilation of the foot. An *air-impervious* area A on the layer 5 of *vapor-permeable* material, a plurality of channels 7, 107 and a plurality of holes 4, 104 would not achieve optimum ventilation of the foot. Thus, the proposed modification described in the Office Action would render the innerboot 1 of the Pozzobon patent unsatisfactory for its intended purpose.

Appellant respectfully asserts that one of ordinary skill in the art would not combine the Pozzobon patent and the Garbuio patent with the Clement et al patent. The wedging element 5 of the Clement et al patent is made of thermoplastic foam and is positioned between the exterior wall 11 and the interior wall 12 in a heel portion of the liner 1. A majority of the liner 1 has foam 13 that is simply compressible between the exterior wall 11 and the interior wall 12.

In contrast, the innerboot 1 of the Pozzobon patent has a thermoformable material *throughout* the innerboot 1. One of ordinary skill in the art would not be motivated to provide a wedging element made of thermoplastic foam when the innerboot 1 of the Pozzobon patent already contains a thermoformable layer 3 *throughout*. Indeed, the layer 3 of thermoplastic material *throughout* the innerboot 1 of the Pozzobon patent would most likely secure the foot as well as would two wedging elements 5 and 6 positioned within foam 13 that is simply compressible. Thus, there is no suggestion in any of the references as to why one of ordinary skill in the art would be motivated to place a wedging element in the innerboot 1 of the Pozzobon patent when the innerboot 1 already has the same thermoformable features provided by the wedging element 5 of the Clement et al patent *throughout* the innerboot 1. Accordingly, one of skill in the art would *not be motivated* to combine the Pozzobon patent and the Garbuio patent with the Clement et al patent.

In addition, independent claims 13 and 28 require that the first and second banana-shaped pads be located between the thermoformable layer and the inner layer. On page 4 of



the January 10, 2006 Office Action, the Examiner states that because the Clement et al patent teaches the wedging element 5 between the exterior wall 11 and the inner wall 12, “it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an inner layer inside the thermoformable layer with the banana-like pads located there between to provide for better and proper cushioning of the boot on the user’s foot.”

However, as stated above, the Garbuio patent requires at column 2, lines 35-38 that the *interiorly* facing pads 8 of the *boot 1* interact with the *exteriorly* facing *air-impervious* area A of the *liner 2* for effective cushioning of the foot without materially impeding its mobility. Therefore, if the pads 8 of the Garbuio patent were placed in the liner 2 or innerboot 1 between the exterior and interior walls like the wedging element 5 of the Clement et al patent, then the teachings of the Garbuio patent would be destroyed. That is, the pads 8 would be unable to contact the *exteriorly* facing *air-impervious* area A for effective cushioning of the foot without materially impeding its mobility.

**B. Rejection under 35 U.S.C. §103(a) over the Pozzobon patent in view of the Garbuio patent and the Clement et al patent and further in view of the Breuner patent**

*The Pozzobon, Garbuio, Clement et al and Breuner patents are not combinable because there is no suggestion or motivation to combine as stated above and because the Breuner patent does not remedy the deficiencies of the Pozzobon, Garbuio, Clement et al patents.*

The Breuner patent discloses a boot structure, an upper 38 and a liner 48. The boot structure includes an outer sole 12, a midsole 16, a sidewall 18 and yokes 26, 28. The Breuner patent does not remedy the deficiencies of the Pozzobon, Garbuio and the Clement et al patents. The Breuner patent does not disclose a boot liner with an upper portion that has a thermoformable layer and first and second banana-shaped pads. Accordingly, one of ordinary skill in the art would not be motivated to combine the Pozzobon, Garbuio, Clement et al and Breuner patents.

***Even if the Pozzobon patent, the Garbuio patent, the Clement et al patent and the Breuner patent could somehow be considered combinable, the references do not disclose all of the claimed elements.***

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Appellant respectfully asserts that a *prima facie* case of obviousness has not been established since all of the claim limitations are not taught or suggested by the Pozzobon patent, the Garbuio patent, the Clement et al patent and the Breuner patent.

***The combination of references to reject independent claims 13 and 28 does not show first and second banana-shaped pads being thicker than a thermoformable layer.***

Independent claims 13 and 28 recite, *inter alia*:

A boot liner comprising:  
a sole portion; and  
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, ***said upper portion including a thermoformable layer*** located on an inner side and an outer side of said ankle section, ***a first banana-shaped pad*** located in said outer side of said ankle section, ***and a second banana-shaped pad*** located in said inner side of said ankle section...

***each of said first and second banana-shaped pads being thicker than said thermoformable layer*** of said ankle section and extending laterally towards each other relative to said thermoformable layer of said ankle section,  
said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of *said boot liner* at bottom and rearward sides of the ankle joint of the wearer....

In the Pozzobon, Garbuio and Clement et al combination rejection, the Garbuio patent is relied on to teach first and second banana-shaped pads. However, the thickness of the pads 8 in the Garbuio patent is not discussed or illustrated. The Pozzobon and Clement et al patents do not remedy the deficiency of the Garbuio patent. The Pozzobon and Clement et al patents disclose thermoformable layers without showing a banana-shaped pad and therefore do not show a thickness in relation to a banana-shaped pad. Therefore, the limitation of the first and

second banana-shaped pads being thicker than the thermoformable layer is not disclosed by this combination of references.

On page 3 of the January 10, 2006 Office Action, the Examiner states:

Garbuio '916 teaches that the pair of elastic pads 8 could be made of the same material as that of the core 4. As shown in Figure 4, the core material 4 is thicker than the thermoformable layer 3 and therefore, the pads 8 of Garbuio '916 would be thicker than the thermoformable layer, as taught by Garbuio '916.

Appellant respectfully asserts that the fact that the pair of elastic pads 8 could be made of the same material as that of the core 4 does not necessarily disclose the thickness of the elastic pads 8. The pads 8 could be made of any thickness from the same material as the core 4.

Moreover, the Examiner designates the fabric layer 3 of the Garbuio patent as the thermoformable layer. Yet, on page 2 of the Office Action, the Examiner uses the Pozzobon patent as the primary reference to show the thermoformable layer. The Examiner has designated two separate elements in the references as the same element in the claims. The Examiner relies on the Pozzobon patent to show the claimed features of the thermoformable layer then designates the Garbuio patent as disclosing the rest of the claimed features of the thermoformable layer. It is well established in patent law that two separate elements in the references cannot be designated as the same claimed element. Moreover, if the Examiner is suggesting a combination of the layers, a motivation to do so has not been set forth.

***The combination of references to reject independent claims 8, 13 and 28 does not show an upper portion of a boot liner with first and second banana-shaped pads.***

Claims 8, 13 and 28 recite, *inter alia*:

A boot liner comprising:  
a sole portion; and  
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, ***said upper portion including*** a thermoformable layer located on an inner side and an outer side of

said ankle section, *a first banana-shaped pad located in said outer side* of said ankle section, and *a second banana-shaped pad located in said inner side* of said ankle section...

said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of *said boot liner* at bottom and rearward sides of the ankle joint of the wearer....

As can be seen above, independent claims 8, 13 and 28 require an upper portion of a boot liner to have first and second banana-shaped pads. The Examiner asserts that the Garbuio patent discloses first and second banana-shaped pads in an upper portion of a boot liner. The Garbuio patent illustrates the pad 8 in Figure 1. Under the “Brief Description of the Drawing” heading in column 1 of the Garbuio patent, Figure 1 is described as a sectional view of a *ski boot 1* lined with an insert 2. Figure 2 is described as an elevational view of the *insert 2 without the boot 1*.

Most importantly, Figure 2 does not show the banana-shaped pad 8. This is because the pad 8 is *not part of the liner 2*. Rather, the pad 8 is separate from the liner 2 and, as described at column 2, line 29 of the Garbuio patent, is juxtaposed with the insert 2. That is, the pad 8 and the liner 2 are side by side. The pad 8 is clearly part of the boot 1 and lies next to the insert 2.

Not only is the banana-shaped pad 8 separate from the liner 2, but it is also *exteriorly* juxtaposed with the insert 2. This is in *direct contradiction* with claims 8, 13 and 28, which require a boot liner with an upper portion having a first banana-shaped pad located *in* the outer side of the ankle section and a second banana-shaped pad located *in* the inner side of the ankle section.

On page 5 of the Office Action, the Examiner states:

The claims only require that the pad be located in the inner and outer sides of the upper, but do not require the pads to be part of the upper.

Independent claims 8, 13 and 28 clearly state “an upper portion having ... an ankle section..., said upper portion including ... a first banana-shaped pad located in said outer side of said

ankle section, and a second banana-shaped pad located in said inner side of said ankle section....” Independent claims 8, 13 and 28 clearly state that the upper portion has an ankle section. Therefore, a first banana-shaped pad is located *in* the outer side of the ankle section *of the upper portion* and a second banana-shaped pad is located *in* the inner side of the ankle section *of the upper portion*.

*The combination of references to reject independent claim 13 does not show first and second banana-shaped pads located between a thermoformable layer and an inner layer disposed on an interiorly facing side of the thermoformable layer.*

Since the Garbuio patent discloses a pad 8 that is disposed in a boot 1 *exterior* to the insert 2, it is impossible for the combination to teach first and second banana-shaped pads between a thermoformable layer and an inner layer disposed on an *interiorly* facing side of the thermoformable layer. At best, the combination shows a pad juxtaposed with an *exteriorly* facing side of an insert having a thermoformable layer.

*The combination of references to reject independent claims 8 and 28 does not show a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of the second banana-shaped pad.*

Independent claims 8 and 28 recite, *inter alia*:

...said upper portion including a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad....

The Office Action cites the Breuner patent for the teaching of first and second strap portions. As shown in Figure 6 of the Breuner patent, the boot liner 48 does not have a tightening device fixed to an upper portion of the boot liner 48. The Breuner patent discloses yokes 26 and 28, which are fixed to the *boot* 12, 18 itself not the boot liner 48. See column 5, lines 7 and 8 of the Breuner patent.

Accordingly, for the reasons above, Appellant asserts that a *prima facie* case of obviousness has not been established since all of the claim limitations are not disclosed.


“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” MPEP §2143.03 citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, Appellant respectfully asserts that claims 6, 7, 9-12 and 15-27 are patentable over the Pozzobon patent, the Garbuio patent, the Clement et al patent and the Breuner patent since the prior art of record does not disclose or suggest the invention as set forth in independent claims 8, 13 and 28, as detailed above.

Moreover, Appellant believes that dependent claims 6, 7, 9-12 and 15-27 are further allowable because they include additional limitations. For example, dependent claims 7 and 16 recite that each of the first and second banana-shaped pads has a height of approximately 70 millimeters and a length of approximately 70 millimeters. Dimensions of the pads 8 in the Garbuio patent, which the Examiner relies on to show banana-shaped pads, are not taught. Thus, Appellant believes the prior art of record does not disclose or suggest the invention as set forth in the dependent claims.

**8. Conclusion**

In view of the above analysis of claims 6-13 and 15-28, Appellant believes that the unique arrangements of these claims are not disclosed or suggested in the references cited in the Office Action, either alone, or in combination. Thus, Appellant respectfully requests that the rejections of claims 6-13 and 15-28 be reversed, and that claims 16-13 and 15-28 be allowed. If there are any questions regarding this Brief, please feel free to contact the undersigned.

Respectfully submitted,

  
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### *A- Claims Appendix*

Claims 1 - 5 (Cancelled)

6. (Previously Presented) The boot liner according to claim 13, wherein said first and second banana-shaped pads are formed of a polyurethane material.

7. (Previously Presented) The boot liner according to claim 26, wherein each of said first and second banana-shaped pads has a height of approximately 70 millimeters and a length of approximately 70 millimeters.

8. (Previously Presented) A boot liner comprising:

a sole portion; and

an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section,

said upper portion including a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad,

said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer.

9. (Previously Presented) The boot liner according to claim 13, wherein said thermoformable layer further extends along said foot section.

10. (Previously Presented) The boot liner according to claim 9, wherein said thermoformable layer further extends along said leg section

11. (Previously Presented) The boot liner according to claim 10, wherein



said upper portion includes a foam layer disposed on an interiorly facing side of said thermoformable layer.

12. (Previously Presented) The boot liner according to claim 11, wherein said upper portion includes an outer layer disposed on an exteriorly facing side of said thermoformable layer.

13. (Previously Presented) A boot liner comprising:  
a sole portion; and  
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section, said first and second banana-shaped pads being constructed of a different material than said thermoformable layer,  
each of said first and second banana-shaped pads being thicker than said thermoformable layer of said ankle section and extending laterally towards each other relative to said thermoformable layer of said ankle section,  
said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer, and  
said upper portion including an inner layer disposed on an interiorly facing side of said thermoformable layer with said first and second banana-shaped pads located between said thermoformable layer and said inner layer.

14. (Cancelled)

15. (Previously Presented) The boot liner according to claim 8, wherein said first and second banana-shaped pads are formed of a polyurethane material.

16. (Previously Presented) The boot liner according to claim 27, wherein each of said first and second banana-shaped pads has a height of approximately 70 millimeters and a length of approximately 70 millimeters.

17. (Previously Presented) The boot liner according to claim 13, wherein said sole portion is a separate member that is coupled to said foot section of said upper portion.
18. (Previously Presented) The boot liner according to claim 17, wherein said sole portion is constructed of at least one flexible material.
19. (Previously Presented) The boot liner according to claim 13, wherein said sole portion includes an outer sole section that is fixedly coupled to said foot section of said upper portion.
20. (Original) The boot liner according to claim 19, wherein said outer sole section of said sole portion includes an exterior layer of a polyvinyl chloride material.
21. (Original) The boot liner according to claim 20, wherein said outer sole section of said sole portion further includes an interior thermoformable layer.
22. (Original) The boot liner according to claim 21, wherein said sole portion further includes an inner sole section that overlies said outer sole section of said sole portion.
23. (Previously Presented) The boot liner according to claim 13, wherein said sole portion further includes ~~an~~ a thermoformable layer.
24. (Previously Presented) The boot liner according to claim 23, wherein said upper portion includes a tongue portion coupled to said upper portion and arranged to span a longitudinal slit formed in said leg section, and a tightening device coupled to said upper portion for drawing opposite lateral sides of said upper portion that define said slit towards one another.
25. (Previously Presented) The boot liner according to claim 19, wherein

said tightening device includes a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad.

26. (Previously Presented) The boot liner according to claim 13, wherein each of said first and second banana-shaped pads has a maximum vertical height and a maximum horizontal width that is approximately equal to said maximum vertical height to cradle the ankle bone of the wearer.

27. (Previously Presented) The boot liner according to claim 8, wherein each of said first and second banana-shaped pads has a maximum vertical height and a maximum horizontal width that is approximately equal to said maximum vertical height to cradle the ankle bone of the wearer.

28. (Previously Presented) A boot liner comprising:  
a sole portion; and  
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, said upper portion including a thermoformable layer located on an inner side and an outer side of said ankle section, a first banana-shaped pad located in said outer side of said ankle section, and a second banana-shaped pad located in said inner side of said ankle section, said first and second banana-shaped pads being constructed of a different material than said thermoformable layer,

each of said first and second banana-shaped pads being thicker than said thermoformable layer of said ankle section and extending laterally towards each other relative to said thermoformable layer of said ankle section,

said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of said boot liner at bottom and rearward sides of the ankle joint of the wearer, and

said upper portion including a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad.

***B- Evidence Appendix***

Appellants are not relying on any additional evidence in this appeal of the above-identified patent application other than the present record presented in the appeal brief.

***C- Related Proceeding Appendix***

Since Appellants are not aware of any appeals or interferences relating to the above-identified patent application, there are no decisions rendered by a court or the Board that are believed to be required to be submitted herewith.